

Serial Number 09/981,611 filed October 16, 2001

REMARKS

1. Claim 24 has been amended to incorporate the limitations of ballistic effectiveness (support found on page 1, line 9; page 5, line 5; and in the examples), flexibility (support found on page 1, line 9; page 5, line 5; page 23, lines 8-25), size of the matrix islands (page 9, line 8) and volume ratio of the matrix (support found on page 7, lines 10-13). Since new matter has not been added, it is respectfully submitted that the amendments should be entered.

2. Claims 24-26 stand rejected under 35 USC §102(b) as being anticipated by Schirtzinger, USP3,686,048 (the '048 patent). Applicants traverse this rejection and request its withdrawal for the reasons that follow.

Claim 24, as amended, includes limitations that have no counterpart in the '048 patent:

a) ballistic effectiveness - In contrast to the present invention, the '048 patent does not describe or suggest a ballistically effective composite.

b) flexibility - In contrast to the present invention, the '048 patent is directed to a high strength structural material, i.e. a rigid material (see columns 1-2).

c) size of the matrix islands - In contrast to the present invention, the '048 patent provides no definite limitation on the size of the matrix islands. "Minute bridges" are mentioned at column 3, line 36, but no guidance is provided as to the meaning of this term.

d) final volume ratio of the matrix - In contrast to the method of the present invention, the '048 patent provides for a "pre-ply" that becomes filled with matrix material in its final state (column 2, lines 49-54).

Thus, the '048 patent fails to teach or suggest applicants' claimed invention. And in view of the different objectives of the present invention (ballistic effectiveness) and the '048 patent (a structural material), it is respectfully submitted that the skilled man seeking a ballistically effective, flexible material would not seek direction from the '048 patent except with the impermissible use of hindsight. It is also highly unlikely that routine experimentation for the purpose of providing a structural material would yield the same result for the size of the matrix islands as described in the present invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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"Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See e.g. *Corning Glass Works v Sumitomo Elec., U.S.A., Inc.*, 868 F.2d 1251, 1257, 9USPQ2d 1962, 1966 (Fed. Cir. 1989)" M.P.E.P. 2111.02

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed.Cir. 1993)

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.Cir. 1999) (citations omitted)

"If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

3. The Examiner indicates that the discrete matrix islands of the '048 patent (column 3, line 9, through column 4, line 56) are formed from an elastomer. Applicants do not find the term "elastomer" in the '048 patent.

4. In light of the foregoing amendment and remarks, it is submitted that the claims now of record, 24-26 are allowable and should be passed to issue. Applicants respectfully request the same. The Examiner is invited to call the undersigned attorney if there are any unresolved issues to discuss same.

Respectfully submitted,
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I hereby certify that this correspondence is being deposited with the United States Patent & Trademark Office via facsimile to Examiner Elizabeth Cole, Group Art Unit 1771, at 703-872-9310 on May 9, 2003.

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